



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MEMORANDUM

DATE: November 12, 2002

TO: Bruce Kisliuk, Director
Technology Center 1642

FROM: *Sherry S. Brinkley*
Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT: Application No. 08/488,180

The above-identified application is being referred to the Technology Center to consider the petition to withdraw the application from issue under 37 CFR 1.313(a). While the issue fee has been paid, a patent number and issue date have not yet been assigned. If it is deemed necessary to withdraw the case, please do so, per authority granted to you by Deputy Assistant Commissioner Kunin's memo of January 20, 1999. See attached.

Attachment



Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

B. Baker

FBI

MEMORANDUM

DATE: January 20, 1999

TO: Technology Center Group Directors

FROM: Stephen G. Kunin *Stephen G. Kunin*
Deputy Assistant Commissioner for
Patent Policy and Projects

SUBJECT: Delegation of authority to withdraw an application from issue after payment of the issue fee.

You are hereby delegated the authority to withdraw an application from issue after payment of the issue fee under 37 CFR 1.313(b). This grant of authority is limited to those situations in which the request for withdrawal from issue is at the initiative of the Patent and Trademark Office (PTO). You may **not** further delegate this grant of authority.

The authority to decide petitions by an applicant under 37 CFR 1.313(b) is delegated to the Office of Petitions. The Office of Petitions is also delegated the authority to withdraw an application from issue after payment of the issue fee under 37 CFR 1.313(b) in those situations in which the request for withdrawal from issue is at the initiative of the PTO by someone other than a Group Director.

35 U.S.C. § 151 provides that upon payment of the issue fee, "the patent shall issue." See 35 U.S.C. § 151, ¶ 2. Thus, an application cannot be withdrawn from issue after payment of the issue fee consistent with 35 U.S.C. § 151 unless there has been a determination that at least one of the conditions specified at 37 CFR 1.313(b)(1) through (5) exist such that the applicant is no longer "entitled to a patent under the law" as provided in 35 U.S.C. § 151. See *Harley v. Lehman*, 981 F. Supp. 9, 11-12, 44 USPQ2d 1699, 1701-02 (D.D.C. 1997) (Commissioner may adopt rules permitting applications to be withdrawn from issue after payment of the issue fee in situations in which the applicant is not entitled to a patent under the law); and see *Sampson v. Dann*, 466 F. Supp. 965, 973-74, 201 USPQ 15, 22 (D.D.C. 1978) (Commissioner not authorized to withdraw an application from issue after payment of the issue fee on an *ad hoc* basis, but only in situations which meet the conditions of 37 CFR 1.313(b)).

35 U.S.C. § 151 and 37 CFR 1.313(b) do not authorize the PTO to withdraw an application from issue after payment of the issue fee for any reason except:

- (1) a mistake on the part of the Office;
- (2) a violation of 37 CFR 1.56 or illegality in the application;

(3) unpatentability of one or more claims;
(4) for interference; or
(5) for abandonment to permit consideration of an information disclosure statement under 37 CFR 1.97 in an already filed continuing application.
See 37 CFR 1.313(b).

Examples of reasons that do **not** warrant withdrawing an application from issue after payment of the issue fee are: (1) to permit the examiner to consider an information disclosure statement; (2) to permit the examiner to consider whether one or more claims are unpatentable; or (3) to permit the applicant to file a continuing application (including a CPA). An application may be removed from the Office of Patent Publication, without it being withdrawn from issue under 37 CFR 1.313(b), to permit the examiner to consider an information disclosure statement or whether one or more claims are unpatentable. Only if such consideration results in a determination that one or more claims are unpatentable does 37 CFR 1.313(b) authorize the application to be withdrawn from issue. If uncertainty exists as to whether prosecution will in fact be re-opened, the uncertainty must be resolved before the application is withdrawn from issue.

Any notice withdrawing an application from issue after payment of the issue fee must specify which of the conditions set forth in 37 CFR 1.313(b)(1) through (5) exists and thus warrant withdrawal of the application from issue.

Any petition under 37 CFR 1.181 to review the decision of a Group Director to withdraw an application from issue after payment of the issue fee will be decided by me.

As discussed above, the Office of Petitions also has the authority to withdraw an application from issue after payment of the issue fee under 37 CFR 1.313(b) in those situations in which the request for withdrawal from issue is at the initiative of the PTO by someone other than a Group Director. If there is a question whether an application must be withdrawn from issue and no Group Director is available to decide whether withdrawal from issue is appropriate and to sign the withdrawal Notice, the application should be hand-carried to the Office of Petitions for decision on whether withdrawal from issue is appropriate and to effect the withdrawal.

Questions concerning withdrawal from issue may be directed to the Office of Petitions at 305-9282.

The procedure set forth below is to be followed when a Group Director withdraws an application from issue. This processing is to be done in the Technology Center without the need to send the application to the Office of Patent Publication.

These procedures will be incorporated into the next revision of the MPEP.

Procedure to be followed when an application is withdrawn from issue:

Determine (via the CRT Screen on PALM) whether the issue fee has been paid, and whether the application has been assigned a patent number and issue date.

(1) If the issue fee **has not** been paid: withdraw the application from issue in accordance with the procedure set forth in MPEP 1002.02(c), item 18 (as modified by the memorandum of January 16, 1998 entitled "New File Wrappers"), using form paragraph 10.01.

(2) If the issue fee **has** been paid:

(a) Prepare, sign, date stamp, and mail a "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" **to the applicant** indicating that the application has been withdrawn from issue (using one of the attached form letters WDR-TCB1, WDR-TCB2, WDR-TCB3, or WDR-TCB4). **Do NOT use form paragraph 10.02 to effect withdrawal of an application from issue because it is now obsolete.**

(b) **If the application has been assigned a patent number and issue date:**

(i) Prepare a "Withdrawal from Issue of" memorandum using the attached form memorandum WDR-MEMO. **E-mail the memorandum to the Director of the Office of Patent Publication and the persons copied on the memorandum to inform them that the application has been withdrawn from issue.**

(ii) The "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" letter to applicant discussed in (a) must be signed, date stamped, and mailed no later than the Monday before the issue date to be effective to withdraw the application from issue.

(c) Change the status of the application to status code 066 (Previous Action Withdrawn-Awaiting Further Action) by using PALM transaction code 1040. Enter the "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" (and the "Withdrawal from Issue of" memorandum discussed in (b)(i) above if applicable) in the application file and make it (them) of record on the application file contents.

(d) Stick an Issue Information Label (Form 2016) on the file wrapper (see the memorandum of January 16, 1998 entitled "New File Wrappers") over the filled-in boxes on the file wrapper that contain issue information.

(e) Forward the application to the examiner for prompt appropriate action (e.g., reopen prosecution, initiate interference proceedings).

Attachments: Form Letters WDR-TCB1
WDR-TCB2
WDR-TCB3
WDR-TCB4
WDR-MEMO

Memorandum of January 16, 1998 entitled "New File Wrappers"
Issue Information Label (Form 2016)



UNITED STATES PATENT AND TRADEMARK OFFICE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
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Washington, D.C. 20231

Paper No. KEYBOARD()

WDR-TCB1

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In re Application of
KEYBOARD()
Application No. KEYBOARD()
Filed: KEYBOARD()
Attorney Docket No. KEYBOARD()

**NOTICE OF WITHDRAWAL
FROM ISSUE
UNDER 37 CFR 1.313(b)**

The above-identified application is withdrawn from issue after payment of the issue fee due to a mistake on the part of the Office. See 37 CFR 1.313(b)(1).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to KEYBOARD() at (703) KEYBOARD().

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

KEYBOARD()



Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. KEYBOARD()

WDR-TCB2

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In re Application of :
KEYBOARD() :
Application No. KEYBOARD() :
Filed: KEYBOARD() :
Attorney Docket No. KEYBOARD() :

**NOTICE OF WITHDRAWAL
FROM ISSUE
UNDER 37 CFR 1.313(b)**

The above-identified application is withdrawn from issue after payment of the issue fee due to a violation of 37 CFR 1.56 or illegality in the application. See 37 CFR 1.313(b)(2).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to KEYBOARD() at (703) KEYBOARD().

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

KEYBOARD()



Patent and Trademark Office
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Washington, D.C. 20231

Paper No. KEYBOARD()

WDR-TCB3

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In re Application of :
KEYBOARD() :
Application No. KEYBOARD() :
Filed: KEYBOARD() :
Attorney Docket No. KEYBOARD() :

**NOTICE OF WITHDRAWAL
FROM ISSUE
UNDER 37 CFR 1.313(b)**

The above-identified application is withdrawn from issue after payment of the issue fee due to unpatentability of one or more claims. See 37 CFR 1.313(b)(3).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allqwance in order to prevent abandonment of the application.

Telephone inquiries should be directed to KEYBOARD() at (703) KEYBOARD().

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

KEYBOARD()



Patent and Trademark Office
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PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. KEYBOARD()

WDR-TCB4

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In re Application of
KEYBOARD()
Application No. KEYBOARD()
Filed: KEYBOARD()
Attorney Docket No. KEYBOARD()

**NOTICE OF WITHDRAWAL
FROM ISSUE
UNDER 37 CFR 1.313(b)**

The above-identified application is withdrawn from issue after payment of the issue fee for interference. See 37 CFR 1.313(b)(4).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to KEYBOARD() at (703) KEYBOARD().

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

KEYBOARD()



Paper No. KEYBOARD0

WDR-MEMO

Date : DATE

TO : Director, Office of Patent Publication

FROM : Director, Technology Center KEYBOARD0

SUBJECT : Withdrawal from Issue of

Applicant : KEYBOARD0

Application No. : KEYBOARD0

Filed : KEYBOARD0

The above-identified application has been assigned Patent No. KEYBOARD0 and an issue date of KEYBOARD0.

The above-identified application has been withdrawn from issue.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of KEYBOARD0:

"All reference to Patent No. KEYBOARD0 to KEYBOARD0 of KEYBOARD0 for KEYBOARD0 appearing in the Official Gazette of KEYBOARD0 should be deleted since no patent was granted."

KEYBOARD0

KEYBOARD0

cc: Geraldine Dozier, Office of Electronic Information Products, Crystal Park 3-441
Deneise Boyd, Office of System and Network Management, Crystal Park 2, Suite 1100
Nancy Hurd, Office of Patent Publication, Crystal Park 3-910
Niomi Farmer, Office of Patent Publication, Crystal Park 3-910